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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,305	07/30/2001	Yutaka Wada	2001-1079	9053
513	7590	12/22/2003	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			MCDONALD, SHANTESE L	
		ART UNIT	PAPER NUMBER	
		3723	13	
DATE MAILED: 12/22/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/916,305</b>	Applicant(s) <b>Wada et al.</b>
	Examiner <b>McDonald, Shantese</b>	Art Unit <b>3723</b>
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		
<b>Period for Reply</b> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).		
<b>Status</b>		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Aug 25, 2003</u>		
2a) <input type="checkbox"/> This action is FINAL.      2b) <input checked="" type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.		
<b>Disposition of Claims</b>		
4) <input checked="" type="checkbox"/> Claim(s) <u>1-3, 5-8, 54-76, 78, and 82-106</u> is/are pending in the application.		
4a) Of the above, claim(s) _____ is/are withdrawn from consideration.		
5) <input checked="" type="checkbox"/> Claim(s) <u>1-3, 5-8, 78, and 102-104</u> is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>54, 55, 57-62, 65, 66, 68-74, 76, 82, 83, 86-90, 93, 94, 96-99, 101,</u> is/are rejected.		
7) <input checked="" type="checkbox"/> Claim(s) <u>56, 63, 64, 67, 75, 84, 85, 91, 92, 95, and 100</u> is/are objected to.		
8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.		
<b>Application Papers</b>		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
<b>Priority under 35 U.S.C. §§ 119 and 120</b>		
13) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input checked="" type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input checked="" type="checkbox"/> Certified copies of the priority documents have been received in Application No. <u>09/444,764</u> . 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). *See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.		
15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
<b>Attachment(s)</b>		
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
6) <input type="checkbox"/> Other: _____		

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in-
  - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
  - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 54,5859,61-62,65,74,76,82,86,87,89,90,93,99 and 105 are rejected under 35

U.S.C. 102(e) as being anticipated by Li et al.

Li et al. teaches a method of polishing an object using a holder, 80, for holding the object, an abrading surface made of abrasive particles and a binder binding the abrasive particles, (col. 8, lines 61-65), the method comprising dressing, with a diamond particle dresser, which is a flat tool, (col.6, lines 24-36)the abrading surface, prior to a polishing process, (col. 6, lines 24-37), pressing the object against the abrading surface, applying a pressurized fluid on the abrading surface, (col. 8, lines 10-22), and polishing the object by making a sliding motion between a surface of the object and the abrading surface.

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***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 55,57,60,66,68-73,83,88,94,96-98,106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al.

Li et al. teaches all the limitations of the claims except for the surface roughness of the abrading surface is less than  $\pm 30\text{ }\mu\text{m}$  after the dressing process, a ratio of the abrasive particles and a material of the binder is 1:x, where x is not less than 0.5 by volume, and proportions of the abrasive particles , the binder and porosity are respectively not less than 10%, not more than 60% and 10-40% by volume, the dresser comprising diamond particles of #100 size, and #200 size electro-deposited in a nickel base, the pressure of the pressured fluid is less than 5kgPa, pressing the dresser with a pressure of less than 50 and 100g/cm<sup>2</sup>. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to provide the invention of Li et al. with the above listed limitations since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In reference to the dresser comprising diamond particles electro-deposited in a nickel base, it has been held to be within the general skill of a worker in the art to select a

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known material on the basis of its suitability for the intended use as a matter of obvious design choice.

***Allowable Subject Matter***

5. Claims 56,63,64,67,75,84,85,91,92,95,100 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claims 1-3,5-8, 78 and 102-104 are allowed.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-3,5-8 and 54-106 have been considered but are moot in view of the new ground(s) of rejection.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shantese McDonald whose telephone number is (703) 308-8722.



Joseph J. Hail, III  
Supervisory Patent Examiner  
Technology Center 3700

S.L.M.

December 10, 2003